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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/560,779 | 04/28/2000 | Danne L. Buchanan | 7905-15 | 5156 |
| 22428 | 7590 | 03/31/2004 | EXAMINER | |
| FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007 | | | NGUYEN, NGA B | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3628 | |

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,779

Applicant(s)

BUCHANAN ET AL.

Examiner

Nga B. Nguyen

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ME

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-139 is/are pending in the application.
- 4a) Of the above claim(s) 1-46, 61-74, 89-102, 117 and 118 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-60, 75-88, 103-116 and 119-139 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 18.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the Amendment filed on October 20, 2003, which paper has been placed of record in the file.
2. Claims 47-60, 75-88, 103-116 and 119-139 are elected for consideration.

Response to Arguments/Amendment

3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
4. Applicant's arguments with respect to claims 47-60, 75-88, 103-116 and 119-139 have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 47-60, 75-88, 103-116 and 119-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geer, U.S. Patent No. 5,930,778, in view of Lowrey, U.S. Patent No. 6,189,785, in view of Hanaoka et al. (herein after Hanaoka), U.S. Patent No. 6,257,783, and further in view of Campell et al (hereinafter Campell), U.S. Patent No. 5,373,550.

Regarding to claim 47, Geer discloses a method for deposit processing at a central site a plurality of original checks deposited at a remote site with accompanying deposit information, comprising the steps of:

the central site receiving information including a deposit account designation and where a plurality of checks from different third parties are being deposited by a single depositor a deposit sum, and electronic check data and original check image data for a plurality of checks to be deposited (column 9, lines 1-25 and column 10, line 1-6; the depository bank 10 receives electronic check data and original check image data from different payee's locations; Note that the central site is the depository bank site or the bank of first deposit site, see applicant's invention, figure 1 show that central site is the bank of first deposit check capture system);

the central site providing the electronic deposit data to a main accounting system for a bank of first deposit (column 9, lines 13-15; the depository bank 10 provides the electronic deposit data to a accounting system 13 of the depository bank)

sorting the associated received data (column 9, lines 18-25; the electronic check information is sorted and routed via the electronic sorter 14);

the central site transmitting associate electronic check data and the original check image data directly or indirectly to a maker bank or a print site associated therewith (column 9, lines 18-25; the depository bank 10 transmits the electronic check information to the payor banks).

Geer does not disclose the central site identifying MICR errors and/or image data errors in the electronic check data received; if MICR and/or image data errors are identified in the electronic data, then sending an instruction to the remote site to correct the errors. However, Lowery discloses the central site identifying MICR errors and/or image data errors in the electronic check data received; if MICR and/or image data

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errors are identified in the electronic data, then sending an instruction to the remote site to correct the errors (column 9, lines 10-23; the Depositing Financial Institution 128 identified the check data errors (e.g. not reformatted, reformatted incorrectly, invalid account number, not-located account) and returned to the remote site to correct the errors). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Geer's to incorporate the features taught by Lowery's above for the purpose of providing to the payee at the remote site the ability to recognize the errors in the check data for correction and repair, gives a payee the opportunity not only to receive additional information from the financial institution at the remote site, but also obviates the inconvenience experienced by customers who submit valid check data that is subsequently garbed by, for instance, a malfunctioning check reader.

Geer does not disclose if no errors are identified, the central site sending endorsement and/or voiding authorization to the remote site. However, Geer does teach the remote site applies the electronic endorsements on behalf of the depository bank at the remote site (column 50-55), thus the depository bank does not need to apply the endorsement at the depository bank (column 12, lines 37-67), a communication link between the payee and the depository bank enables the payee and the depository bank to communicate about the check information (column 13, lines 55-65). Moreover, Hanaoka discloses if no errors are identified, the central site sending endorsement and/or voiding authorization to the remote site (column 8, lines 35-47; the check information is verifies by the bank, after the check is confirmed by the bank to be valid, printing the check endorsement information at the remote site, thus the bank authorizes the remote site to print the check endorsement by sending the bank's response or confirmation to the remote site). Therefore, it would have been obvious to one with

ordinary skill in the art at the time the invention was made to modify Geer's to incorporate the features taught by Hanaoka's above for the purpose of providing the authorization to the payee by the depository bank in order to apply the electronic endorsements on behalf of the depository bank at the remote site, thus providing the benefit for both the payee and the bank in the check collecting and clearing sequence, for the faster collection of funds.

Geer does not disclose the central site receiving endorsed and voided check image data; associating the endorsed and voided check image data with the original check image data; and transmitting the endorsed and/or voided check image data directly or indirectly to a maker bank or a print site associated therewith. However, Campell discloses the central site receiving endorsed and voided check image data; associating the endorsed and voided check image data with the original check image data (column 2, lines 39-43; the bank of first deposit receives the image of a check; column 3, lines 5-10; the image of the check include the front and the back of the check); and transmitting the endorsed and/or voided check image data directly or indirectly to a maker bank or a print site associated therewith (column 2, lines 43-50; the bank of first deposit forwards the check image to the payor bank). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Geer's to incorporate the features taught by Campell's above for the purpose of cost saving and time consuming, because it eliminates the use of paper checks.

Regarding to claim 48, Geer discloses sending the electronic check data and the original check image data to a bank of first deposit (column 9, lines 1-25).

Regarding to claim 49, Geer discloses the receiving step comprises: receiving electronic deposit data, electronic check data and original check image data for a

plurality of different deposit transactions, the checks for each one of the plurality of different deposit transactions to be deposited at a different bank of first deposit; and sending each one of a plurality of the different deposit transactions to a respective different bank of first deposit (column 9, lines 10-13).

Regarding to claim 50, Geer discloses reading original check image data to create image information data; and comparing the image information data to the electronic check data (column 8, lines 59-67).

Regarding to claim 51, Geer does not disclose storing at least one of the original check image data and the endorsement/or voided check image data on a server accessible from the Internet. However, accessing the Internet to retrieve the check image is well known in the art. Today there exist many different websites maintained by many different banks (on-line banking) to allow the customers to retrieve the check image over the Internet. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Geer's to include the features above for the purpose of cost saving and time consuming, because it eliminates the use of paper checks.

Regarding to claims 52, 53, 57, Geer discloses determining if a bank of first deposit is a maker bank for the original check (column 9, lines 60-65). Geer does not disclose determining if the maker bank requires a hard copy of the original check; and if it does, sending the original check image data to a print site for printing and sending directly or indirectly to the maker bank; if it does not, sending the original check image data directly or indirectly to the maker bank. However, Geer does teach the image of the physical check is preserve and may be reproduced as a copy of the check for purpose of verification (column 8, lines 10-15). Moreover, Campell teaches if the maker bank requires a hard copy of the check sending the original check image data to a print site

for printing and sending directly or indirectly to the maker bank (column 3, lines 45-52; sending via facsimile equipment); if it does not, sending the original check image data directly or indirectly to the maker bank (column 2, lines 43-46). Therefore, it would have been obvious to include these features with Geer's for the purpose of time consuming, because it eliminates the use of paper checks.

Regarding to claim 54, Lowery discloses if the original check image data is inaccurate or unreadable, then sending the instruction to the remote site to correct without first storing at the central site the original check image data having the error; and receiving corrected original check image (column 9, lines 10-23). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Geer's to incorporate the features taught by Lowery's above for the purpose of providing to the payee at the remote site the ability to recognize the errors in the check data for correction and repair.

Regarding to claim 55, Geer discloses after receiving the data, sending an electronic notification to the remote site that a deposit is complete (column 9, lines 45-50).

Regarding to claim 56, Geer does not disclose formatting the electronic check data and the original check image data for processing in an accounting system of the bank of first deposit. However, formatting the electronic check data is well known in the art of processing checks at the bank of first deposit. Therefore, it would have been obvious to include that feature with Geer's for the purpose of time consuming, because it eliminates the use of paper checks.

Regarding to claim 58, Geer discloses receiving return check image data for a return check coupled with a reference key for an original deposit transaction (column 9, lines 45-50).

Regarding to claim 59, Geer discloses sending the return check image data with the reference key directly or indirectly to the maker bank for re-presentment (column 9, lines 45-50).

Regarding to claim 60, Geer discloses determining if a re-presentment of the returned check requires a duplicate hard copy of the return check or if the original check data image is acceptable for the re-presentment; and if the original check image is acceptable, obtaining a reference key associated with an original deposit transaction; and if the original check image is acceptable, obtaining a reference key associated with an original deposit transaction; and sending directly or indirectly the original check image data and the reference key to the maker bank (column 9, lines 45-50).

Regarding to claim 119, Geer discloses the method further comprise a system with a plurality of different remote sites (column 7, lines 4-25, payee's location), the steps being performed at each of the plurality of remote sites are similar to the steps in claim 47 above.

Regarding to claim 120, Geer discloses the transmitting to the central site step comprises transmitting the original check image data (column 9, lines 1-10).

Regarding to claim 121, Geer does not disclose determining if endorsement information one of the remote sites for printing on the check is up-to-date; and if the endorsement information at the remote site is not up-to-date, then downloading updated endorsement information from the central site. However, checking and obtaining the up-to-date endorsement information is well known in the art of processing checks. Therefore, it would have been obvious to include that feature with Geer's for the purpose of ensuring of endorsement information is an up-to-date endorsement information.

Regarding to claim 122, Geer discloses comparing an amount of a deposit to an amount of one or more checks against a deposit maximum, and providing a rejection notice if the deposit exceeds the deposit maximum (column 9, lines 52-63).

Regarding to claim 123, Geer discloses receiving return check image data for a return check couple with a reference key for an original deposit transaction and a return reason (column 9, lines 45-50).

Regarding to claim 135, Geer discloses sending endorsement information to the remote site to be used to add and endorsement (column 11, lines 40-45).

Regarding to claim 138, Campell discloses the step of transmitting the electronic check data and the check image data directly or indirectly to the maker bank or print site associate therewith transmit both the original check image data and endorsed and voided check image data directly or indirectly to the maker bank or a print site associated therewith (column 2, lines 43-46 and column 3, lines 5-10). Therefore, it would have been obvious to include that feature with Geer's for the purpose of retrieving the electronic image of the checks.

Claims 75-88, 124-128, 136, 139 are written in computer program product, claims 103-116, 129-134, 137 are written in apparatus, that parallel the limitations found in claims 47-60, 119-123, 135, 138 discussed above, therefore are rejected by the same rationale.

Conclusion

7. Claims **47-60, 75-88, 103-116 and 119-139** are rejected.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen, whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough, can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

9. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks
c/o Technology Center 3600
Washington, D.C. 20231

or faxed to:


(703) 872-9326, (for formal communications intended for entry)

or:

(703) 308-3961 (for informal or draft communications, please
label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen
March 19, 2004


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600